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Paper No.

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**DEC 07 2009**

**OFFICE OF PETITIONS**

SLAM DUNK NETWORKS, INC.  
12120 Foothill Lane  
Los Altos Hills CA 94022

In re Application of :  
Gopal et al. :  
Application No. 09/740,718 :  
Patent No. 6,925,482 : DECISION ON TWO PETITIONS  
Filed: December 18, 2000 : PURSUANT TO 37 C.F.R.  
Issue Date: August 2, 2005 : §§ 1.378(B) AND 1.378(C)  
Attorney Docket Number: 72130- :  
0013 :  
Title: ARCHIVAL DATABASE SYSTEM :  
FOR HANDLING INFORMATION AND :  
INFORMATION TRANSFERS IN A :  
COMPUTER NETWORK :

This is a decision on the petition filed pursuant to 37 C.F.R. § 1.378(b) to accept a delayed payment of a maintenance fee for the above-referenced patent.

The petition pursuant to 37 C.F.R. § 1.378(b) is **DISMISSED**.

**Background**

The patent issued on August 2, 2005. The grace period for paying the 3½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on August 2, 2009, with the full payment not having been received.<sup>1</sup> Accordingly, the patent expired on August 2, 2009 at midnight.

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. § 1.378(b) must include:

<sup>1</sup> A check in the amount of \$450 was received on July 10, 2009, when \$555 was due (the \$490 maintenance fee + the \$65 surcharge associated with the late submission of the same). This \$450 was refunded to Patentee via the mailing of a Treasury Check on July 10, 2009.

- (1) the required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);
- (2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1), and;
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent - the showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

With this petition, Petitioner has submitted the surcharge associated with a petition to accept the late payment of a maintenance fee as unavoidable, along with the 3½-year maintenance fee and a statement of facts.

Petitioner has met the first and second requirements of Rule 1.378(b). The failure to meet the third requirement of Rule 1.378(b) will be discussed below.

#### **The standard**

35 U.S.C. § 41(c)(1) states, *in pertinent part*:

The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay<sup>2</sup> is shown to the satisfaction of the Director to have been unavoidable.

37 C.F.R. § 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than

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<sup>2</sup> This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. § 1.378(b).

is generally used and observed by prudent and careful men in relation to their most important business.<sup>3</sup>

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."<sup>4</sup>

The burden of showing the cause of the delay is on the person seeking to revive the application.<sup>5</sup>

#### **Application of the standard to the current facts and circumstances**

Petitioner's explanation of the delay has been considered, and it has been determined that it fails to meet the standard for acceptance of a late payment of the maintenance fee and surcharge.

The period for paying the 3½-year maintenance fee without the surcharge extended from August 2, 2008 to February 2, 2009 and for paying with the surcharge from February 3, 2009 to August 2, 2009. Thus, the delay in paying the 3½-year maintenance fee in full extended from August 2, 2009 at midnight to the filing of this petition on August 25, 2009.

With this petition, Petitioner has asserted that her attorney instructed her to "pay the maintenance fee of \$450 for the small entity of his patent." The date on which this instruction was given has not been made clear; however it appears to have been made prior to June of 2006.<sup>6</sup> On an unspecified date, she "called Patent and Trademark Office and got the Form SB45 for the maintenance fee." Petitioner has further asserted that both the maintenance fee transmittal form and a check in the amount of \$450 was mailed to the Office on April 7, 2009. Office records confirm that payment in the amount of \$450 was received on April

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3 In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

4 Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

5 Id.

6 Petitioner has further indicated that her patent attorney left his law firm in May of 2006.

20, 2009. Since the Office was unable to accept this partial payment of the maintenance fee, Office records show that the \$450 payment was refunded to Petitioner via the preparation of a Treasury Check on July 10, 2009 (Petitioner has confirmed receipt of the same).

The fees that were due at this time were \$490 for the 3½-year maintenance fee (for a small entity) and \$65 for the late submission of the same within six months of the due date, with no reduction for small entity status (the maintenance fee payment was submitted after February 3, 2009 but before August 2, 2009). As such, a total of \$545 was due at the time when Petitioner attempted to submit the maintenance fee payment.

Petitioner has further asserted that had she been "notified in April or May of the maintenance fee increase," the proper maintenance fee would have been submitted to the Office. It is noted that Petitioner has made no mention of any attempt to submit the fee that is associated with the late submission of a maintenance fee within six months of the due date.

As such, it appears that Petitioner relied on information that was out of date by three years, and submitted a portion of one of the two fees which were required, without first obtaining the up-to date amount of said fee.

The record does not support a finding that the entire period of delay was unavoidable, for the following reasons:

First, the assertion that Petitioner was not notified of the "maintenance fee increase" is inaccurate: constructive notification appears on the Office's Website. a current listing of the USPTO Fee Schedule may be viewed here:  
<http://www.uspto.gov/web/offices/ac/qs/ope/fees.htm>

Moreover, MPEP §§ 2506 and 2520 each provide notification that maintenance fees may be adjusted every year. This section of the MPEP is reproduced here:  
[http://www.uspto.gov/web/offices/pac/mpep/documents/2500\\_2506.htm#sect2506](http://www.uspto.gov/web/offices/pac/mpep/documents/2500_2506.htm#sect2506)

Still further, it is solely the responsibility of the patentee to assure that the maintenance fee is timely paid (in full) to prevent expiration of the patent.

Secondly, Petitioner failed to submit not only the maintenance fee in full, but the required \$65 fee that is associated with the late submission of a maintenance fee within six months of the due date. As such, even if the maintenance fee had been submitted in full, the submission would have been incomplete.

Third, the record does not contain a showing that Petitioner had steps in place to ensure the timely submission of the maintenance fee. While mention has been made of an instruction from counsel to submit the maintenance fee, the record does not contain a showing of any steps which might have been in place to effectuate this payment. An adequate showing that the delay in payment of the maintenance fees at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Where the record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fees, 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR § 1.378(b).

Fourth, while Petitioner has indicated that she learned of the expiration of this patent during a telephonic conversation with an Office representative, the record does not reveal either the date on which patentee became aware of the expiration of the patent, or the steps taken to file the petition promptly.

It is noted in passing that it does not appear that Petitioner has kept her address current with the Office. She has indicated that an unidentified article of "correspondence was mailed to our old office." The electronic record shows that on June 1, 2006, a Change of Correspondence Address was received, and on June 9, 2006, Office records were updated accordingly to reflect the current address of record. However, it is noted that this is not the address which appears in either the letterhead of Petitioner's letter or the return address on the third page of this petition. In 2006, Petitioner requested (through her attorney) for her official address of record to be changed to an address in Los Altos Hills,<sup>7</sup> however it appears that she is currently located in San Mateo. As such, it appears that Petitioner failed to notify the Office of her change of address to the San Mateo address, and the article of correspondence was properly mailed to the Los Altos Hills address.

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<sup>7</sup> A change of correspondence address request was received from Attorney Ng on June 1, 2006.

### Conclusion

Any request for reconsideration of this decision **must** be filed within **TWO MONTHS** of the mailing date of this decision. Any such petition for reconsideration must be accompanied by the \$400 petition fee set forth in § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, on request for reconsideration, it is extremely important that petitioner supply **any** and **all** relevant information and documentation in order to meet her burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Petitioner must provide documentation and address the deficiencies noted above. If on request for reconsideration, the delayed payment of the maintenance fees is not accepted, then the maintenance fees are subject to refund following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed.

The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.378(e)". This is not a final agency action within the meaning of 5 U.S.C § 704.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail,<sup>8</sup> hand-delivery,<sup>9</sup> or facsimile.<sup>10</sup> Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.<sup>11</sup>

As set forth above, the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case (subsequent to the change of address that was received on June 1, 2006), although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this patent, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future

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8 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

9 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

10 (571) 273-8300- please note this is a central facsimile number.

11 <https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this patent unless Change of Correspondence Address, Patent Form (PTO/SB/123) is submitted for the above-identified patent. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/123), may be found at <http://www.uspto.gov/web/forms/sb0123.pdf>.

A blank fee address form may be found at <http://www.uspto.gov/web/forms/sb0047.pdf>.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. Inquiries pertaining to the submission of maintenance fees should be directed to the Maintenance Fee branch at 571-272-6500.

/Paul Shanowski/  
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